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09/986,813	11/13/2001	Alistair William McLean	1263.2129	6204

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EXAMINER
HANNE, SARA M

ART UNIT	PAPER NUMBER
2179	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 December 2006*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6,9,10,12-16,18-22,52-54,58,59,61,69,71 and 73-75* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-6, 9-10, 12-16, 18-22, 52-54, 58, 59, 61, 69, 71 and 73-75* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the amendment received on December 26, 2006.

Claims 1, 3-6, 9-10, 12-16, 18-22, 52-54, 58, 59, 61, 69, 71 and 73-75 are pending in

the application. Examiner notes Claim 2 has been cancelled.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

3.   Claims 1, 3-5, 9-10, 12-16, 18-22, 52-54, 58-59, 61, 69, 71 and 73-75 are

rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory

subject matter. MPEP 2106. The claims are drawn to functional descriptive material

NOT claimed as residing on any computer readable medium.   MPEP 2106.IV.B.1(a)

(Functional Descriptive Material) states:

> "Data structures not claimed as embodied in a computer-readable medium are descriptive
> material per se and are not statutory because they are not capable of causing functional change
> in the computer."

> "Such claimed data structures do not define any structural or functional interrelationships between
> the data structure and other claimed aspects of the invention which permit the data structure's
> functionality to be realized."

The claims, while defining an "apparatus", which can range from paper on which

the program is written, to a program simply contemplated and memorized by a person.

Furthermore there are no recited steps that actually perform a display or tangible

result as an outcome of the recited steps, just pieces that are capable of or "operable to"

perform the steps.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5.   Claims 1, 3-6, 9-10, 12-16, 18-22, 52-54, 58-59, 61, 69, 71 and 73-75 are

rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written

description requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. The specification fails to show the combination recited in the

amended claims: "filtering the candidates based on the pre-stored preference data and

the sizes of the candidates".

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

7.   Claims 1, 3-6, 9-10, 12-16, 18-22, 52-54, 61, 69, 71, 73 and 75 are rejected

under 35 U.S.C. 103(a) as being unpatentable over Sanchez et al., US Patent 5832298,

hereinafter Sanchez and further in view of Freeman et al., US Patent 6828992,

hereinafter Freeman.

        As in Claims 1, 61 and 75, Sanchez teaches a user-interface apparatus and

storage medium with processor instructions and method for providing user interfaces

corresponding to each of a plurality of different kinds of devices, the user interface

apparatus comprising a data requester operable to request device description data of a

desired device, the device description data describing a plurality of functions that the

desired device is capable of carrying out (Col. 2, line 36-38), a receiver operable to

receive device description data of the desired device from the desired device via a

network (Col. 2, lines 38-41), an associator operable to associate the functions

described in the received device description data with candidates of user interface

elements, wherein the associator associates each of the functions with a candidate of

user interface element (Col. 2,lines 42 et seq.), a generator operable to generate user

interface for the desired device by laying out candidate user interface elements

associated with the described functions by the associator (Col. 2, lines 43 et seq.),

wherein the generator is common to the plurality of different kinds of devices (MDC) and

is operable to generate a user interface for an of the devices (scanners, faxes, printers,

etc., Col. 13, lines 33-40, local and networked, Col. 5, line 65 et seq.) and a

communicator operable to communicate with the desired device to cause the processor-

controlled machine to carry out a function selected by a user using the user interface

generated by the generator (Col. 2, lines 52 et seq.). While Sanchez teaches the data

requester, communicator, receiver, accessor, associator, and generator for retrieving

device description data and creating a GUI for controlling the device, they fail to show

the preference provider as recited in the claims. In the same field of the invention,

Freeman teaches a universal control system similar to that of Sanchez. In addition,

Freeman further teaches a preference provider providing pre-stored preference data

regarding user interface element preferences, wherein said generator is operable to

select a candidate from amongst the candidates of the a user interface elements based

on the pre-stored preference data and the sizes of the candidates (Col. 4, line 30 et

seq.), and to generate the user interface of the desired device by laying out the selected

candidates of the user interface elements when the associator associates one of the

functions with the candidates of user interface elements (Col. 1, line 60 et seq.). It

would have been obvious to one of ordinary skill in the art, having the teachings of

Sanchez and Freeman before him at the time the invention was made, to modify the

data requester, communicator, receiver, accessor, associator, and generator for

retrieving device description data and creating a GUI for controlling the device taught by

Sanchez to include the providing pre-stored preference data regarding user interface

element preferences along with sizes of candidates to filter interface candidates of

Freeman, in order to obtain pre-stored preference data regarding user preference

governing the display of peripheral device interfaces. One would have been motivated

to make such a combination because a more user-friendly interface for a learned-

control device that is would have been obtained, as taught by Freeman (Col. 1, line 50-

59).

As in Claim 3, Freeman further teaches the preference provider is operable to

provide preference data defining preferences of at least one of the user of the user

interface apparatus and the supplier of the user interface apparatus (Col. 5, lines 46 et

seq.).

As in Claim 4, Freeman further teaches the preference provider is operable to

provide preference data defining for layout of user interface elements (Col. 3, line 67 et

seq.).

As in Claim 5, Freeman teaches preference data defining preferences for

different types of user interface elements such as button user interface elements and

user interface element style preferences to be used for user interface elements (Col.

4,line 15 et seq.).

As in Claim 6, Sanchez teaches the apparatus having a display for displaying the

graphical user interface to a user (Col. 2, line 45 et seq.).

As in Claim 9, Sanchez teaches the data requester operable to communicate

directly with the desired device (Fig. 2 and corresponding text).

As in Claim 10, Sanchez teaches the data requester is operable to communicate

with the desired device via a network to which the desired device is coupled (Col. 3, line

10 et seq. LAN).

As in Claim 12, Sanchez teaches the receiver operable to receive the device

description data directly from the desired device (Col. 5, line 65 et seq.).

As in Claim 13, Sanchez teaches the receiver operable to receive the device

description data using a look-up service provided by a network to which the desired

device machine is coupled (Col. 5, line 45 et seq.).

As in Claim 14, Sanchez teaches the user interface apparatus includes a

processor and associated memory storing a user interface application implementable by

the processor (Col. 5, line 35 et seq.).

As in Claim 15, Sanchez teaches the user interface application comprising

several separate program modules (Col. 3, line 10 et seq.).

As in Claim 16, Sanchez teaches the data requester, communicator, receiver,

accessor, associator, and generator comprise respective different program modules

(each have their own code associated with controlling that aspect).

As in Claim 18, Sanchez teaches a user interface apparatus and device having a

functioner for carrying out a function, a machine communicator for communicating with

the user interface apparatus to enable the user of the user interface to cause the device

to carry out a function, and a device description data provider for providing to the user

interface apparatus upon request by the data requester device description data

describing all of the functions that the device is capable of carrying out (See Claim 1

rejection *supra*). While Sanchez teaches the data requester, communicator, receiver, accessor, associator, and generator for retrieving device description data and creating a GUI for controlling the device, they fail to explicitly show the machine communicator as a wireless device as recited in the claims. In the same field of the invention, Freeman teaches a universal control system similar to that of Sanchez. In addition, Freeman further teaches a wireless device (Col. 3, line 1). It would have been obvious to one of ordinary skill in the art, having the teachings of Sanchez and Freeman before him at the time the invention was made, to modify the data requester, communicator, receiver, accessor, associator, and generator for retrieving device description data and creating a GUI for controlling the device taught by Sanchez to include the wireless functionality of Freeman, in order to obtain a wireless implementation of the learned control device. One would have been motivated to make such a combination because a remote control device that does not tie the user to a specific location via connection cords would have been obtained, as taught by Freeman.

As in Claim 19, Sanchez teaches the functioner is operable to carry out a printing function (Fig. 2 and corresponding text).

As in Claim 20-22, Sanchez teaches the functioner is operable to carry out a facsimile communication function, copying function and scanning function (Fig. 2 and corresponding text).

As in Claim 52, Sanchez teaches user settable data handling parameter defining means having a parameter settable by a user (Col. 3, line 22 et seq.) and data handling means for handling received data in accordance with at least one data handling

parameter set by the user (function carried out by the multimedia processing unit under controls set by the remote).

As in Claim 53, Sanchez teaches the data handling means is operable to divert an incoming message so that the user is not made aware of the message (when device data is received the user is not directly notified of each detail).

As in Claim 54, Sanchez teaches the data handling means is operable to send received data to a location determined by a parameter set by the user (corresponding multimedia processing unit currently being controlled by the interface).

As in Claim 69, Sanchez teaches a network communicator operable to determine whether another device (receiving facsimile machine) that in combination with said desired device provides a further function not otherwise provided by said desired device (sending facsimile machine) is coupled to the network and a user interface controller operable to control the user interface for said desired device in accordance with whether or not the other device is coupled to the network so as to indicate to the user that said further function is not available when said other device is not coupled to the network and to indicate to the user that the further function is available when the other device is coupled to the network along with the limitations of Claim 1 rejected *supra* (cannot activate functions when either unit is off).

As in Claim 73, Sanchez teaches the associator is operable to retrieve a default layout including different panes, and to associate the functions corresponding to each pane of the default layout with candidates of user interface elements, and wherein the generator is operable to generate a user interface of the desired device by laying out

the candidates of the user interface elements associated with the functions by the

associator (Fig. 5 shows separate panes within the default interface of the printer

device).

As in Claim 71, Freeman and Sanchez teach the preference provider is operable

to provide preference data defining preferences for a button (Col. 3, line 16 et seq.

Freeman) and at least one of color, font and font size user interface element styles to be

used for user interface elements (Col. 9, line 2, Sanchez).

8.   Claims 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Sanchez et al., US Patent 5832298, hereinafter Sanchez and Freeman et al., US Patent

6828992, hereinafter Freeman and further in view of Grefenstette et al., US Patent

6498567, hereinafter Grefenstette.

As in Claim 58, Sanchez and Freeman teach a user-interface apparatus and

storage medium with processor instructions and method for providing user interfaces

corresponding to each of a plurality of different devices, the user interface apparatus

comprising a data requester operable to request device description data of a desired

device, the device description data describing functions that the desired device is

capable of carrying out, a receiver operable to receive device description data of the

desired device from the desired device, an associator operable to associate the

functions described in the received device description data with candidates of user

interface elements, a generator operable to generate user interface of the desired

device by laying out candidates of the user interface elements associated with the

described functions by the associator, and a communicator operable to communicate

with the desired device to cause the processor-controlled machine to carry out a function selected by a user using the user interface generated by the generator (See Claim 1 rejection *supra*). While Sanchez and Freeman teach the data requester, communicator, receiver, accessor, associator, and generator for retrieving device description data and creating a GUI for controlling the device, they fail to show the modifying the user interface in response to data identifying the availability of another processor-controlled machine as recited in the claims. In the same field of the invention, Grefenstette teaches a universal control system similar to that of Sanchez and Freeman. In addition, Grefenstette further teaches a user interface modifying means for modifying the user interface in response to data identifying the availability of another processor-controlled machine (Col. 5, line 5 et seq.). It would have been obvious to one of ordinary skill in the art, having the teachings of Sanchez and Freeman and Grefenstette before him at the time the invention was made, to modify the data requester, communicator, receiver, accessor, associator, and generator for retrieving device description data and creating a GUI for controlling the device taught by Sanchez and Freeman to include the modifying the user interface in response to data identifying the availability of another processor-controlled machine of Grefenstette, in order to obtain a remote control device display adaptable to inclusion of a new peripheral device to be controlled. One would have been motivated to make such a combination because an adaptable system for working with a plurality devices that is would have been obtained, as taught by Grefenstette (Col. 1, line 39 et seq.).

As in Claim 59, Sanchez teaches the functioner is operable to carry out a printing

function in response to data identifying the availability of a printer (Fig. 2 and

corresponding text).

9.   Claim 74 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanchez

et al., US Patent 5832298, hereinafter Sanchez and Freeman et al., US Patent

6828992, hereinafter Freeman further in view of US Patent 6658415 Brown et al.,

hereinafter Brown.

Sanchez and Freeman teaches a user-interface apparatus and storage medium

with processor instructions and method for providing user interfaces corresponding to

each of a plurality of different devices, the user interface apparatus comprising a data

requester operable to request device description data of a desired device, the device

description data describing functions that the desired device is capable of carrying out,

a receiver operable to receive device description data of the desired device from the

desired device, an associator operable to associate the functions described in the

received device description data with candidates of user interface elements, a generator

operable to generate user interface of the desired device by laying out candidates of the

user interface elements associated with the described functions by the associator, and a

communicator operable to communicate with the desired device to cause the processor-

controlled machine to carry out a function selected by a user using the user interface

generated by the generator (See Claim 1 rejection *supra*). While Sanchez and

Freeman teaches the data requester, communicator, receiver, accessor, associator,

and generator for retrieving device description data and creating a GUI for controlling

the device, they fail to show the device description data is described by XML as recited

in the claims. In the same field of the invention, Brown teaches a universal control

system similar to that of Sanchez and Freeman. In addition, Brown further the device

description data is described by XML (Col. 4, line 34 et seq.). It would have been

obvious to one of ordinary skill in the art, having the teachings of Sanchez and Freeman

and Brown before him at the time the invention was made, to modify the data requester,

communicator, receiver, accessor, associator, and generator for retrieving device

description data and creating a GUI for controlling the device taught by Sanchez and

Freeman to include the XML of Brown, in order to obtain a remote control device display

the receives device description data in XML format. One would have been motivated to

make such a combination because a common data structure for learning device

functions would have been obtained, as taught by Brown.

Response to Arguments

Applicant's arguments filed 12/26/06 have been fully considered but they are not persuasive.

In response to the applicant's arguments that Sanchez fails to teach "selecting a candidate of each function from a plurality of associated candidates by filtering the candidates based on stored preference data and the sizes of the candidates ...", (pg. 13 of the submitted remarks) the examiner points to the rejection *supra* of Claim 1 citing Freemans teachings, not Sanchez.

In response to the applicant's arguments that Freeman fails to teach "selecting a candidate of each function from a plurality of associated candidates by filtering the candidates based on stored preference data and the sizes of the candidates and generating a user interface for a device by laying out candidates of the user interface elements using the selected candidates", (pg. 13 of the submitted remarks) the examiner disagrees. See rejection of Claim 1 *supra*.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara M. Hanne whose telephone number is (571) 272-4135. The examiner can normally be reached on M-F 7:30am-4:00pm, off on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WEILUN LO can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

smh

WEILUN LO
SUPERVISORY PATENT EXAMINER